

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 3-8, 10-13, 15-18, 20-23, 25-29, and 32-34 are pending and under consideration.

This response is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this response is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicant requests entry of this Rule 116 Response because the response does not alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

I. Rejection under 35 U.S.C. § 103

In the Office Action, at pages 2-5, claims 1, 3-8, 10-13, 15-18, 20-23, 25-29, and 32-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hollon (U.S. Patent No. 5,768,164) in view of Yutaka et al. (JP 09026832) and Kasahara et al. (U.S. Patent No. 5,151,696).

The Examiner acknowledges that the combination of Hollon nor Yutaka et al. does not disclose:

codes that are output as a result of an operation of each of the plurality of buttons correspond to instructions for each of the plurality of buttons and the instructions differ depending on the operation mode of the electronic apparatus,

as recited in claim 1. The Examiner attempts to make up for this deficiency with Kasahara et al. However, it is submitted that Kasahara et al. does not discuss or suggest:

codes that are output as a result of an operation of each of the plurality of buttons correspond to instructions for each of the plurality of buttons and the instructions differ depending on the operation mode of the electronic apparatus,

as recited in claim 1. Claim 1 provides that codes, which correspond to instructions, are output as a result of an operation of each of the plurality of buttons and that the instructions differ depending on the operation mode of the electronic apparatus. In contrast, the modes I, II, and III disclosed in Kasahara et al. are modes of the remote controller itself and do not correspond to modes of the electronic apparatus that the remote controller is intended to control. The Examiner even acknowledges this fact in the Response to Arguments section on page 6 of the Office Action. The Examiner states that “the remote controller is used to control another electronic apparatus” and that “the mode switches (modes I, II, and III) in Kasahara are the multi-function modes of the keyboard and correspond to modes of the keyboard.” Furthermore, col. 2, lines 45-46 clearly discloses “setting one of a plurality of predetermined modes in which the switch array is to be operated.” Thus, the modes disclosed in Kasahara et al. are clearly directed to modes of the keyboard, which is part of the remote controller, itself and do not correspond to mode of the “another electronic apparatus” that the remote controller is designed to control. In other words, Kasahara et al. discloses outputting signals based on an operation mode of the remote controller and not based on the operation mode of the other electronic apparatus that is to be controlled by the remote controller. As such, Kasahara et al. does not teach outputting codes, which correspond to instructions, as a result of an operation of each of the plurality of buttons and that the instructions differ depending on the operation mode of the electronic apparatus.

Also, it would not have been obvious, as the Examiner contends, to one of ordinary skill in the art to modify the apparatus of Hollon nor Yutaka et al. to output codes as taught by Kasahara et al. so as to provide an inexpensive multi-function control apparatus that is capable of controlling a multiplicity of functions of an apparatus to be controlled. However, it is respectfully submitted that there is no motivation to combine the references as the Examiner has indicated. To begin with, both the apparatuses of Hollon and Yutaka et al. already include buttons that are provided on the apparatuses themselves, the operations of which can be manipulated by the user. Therefore, it would not have been obvious to one of ordinary skill in the art to add an additional component (for example, the remote controller of Kasahara et al.) with additional buttons to the combined Hollon and Yutaka et al. apparatus in order to output codes when, according to the Examiner, the combined Hollon and Yutaka et al. apparatus already includes a plurality of buttons and a controller.

Furthermore, the Examiner has indicated that it would have been obvious to modify Hollon by Yutaka et al. so that the auxiliary display “can be used more easily and continuously.” In fact, both Hollon and Yutaka et al. cite the need for convenience and ease of use in disclosing laptop-type electronic apparatuses that include displays that can be read and manipulated when the cover of the laptop is closed. Thus, it would not have been obvious to one of ordinary skill in the art to add an additional component (for example, the remote controller of Kasahara et al.) to the combined Hollon and Yutaka et al. apparatus because such an additional component would add to the complexity involved in using the laptop device by requiring the user to carry around an additional component and control the display with the additional component instead of merely manipulating the buttons already present on the laptop device. MPEP section 2143.01 clearly states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). As described above, a person of ordinary skill in the art would clearly appreciate that the Examiner’s proposed modification would render the combined Hollon and Yutaka et al. apparatus unsatisfactory for its intended purpose.

Since Hollon, Yutaka et al., and Kasahara et al., alone or in combination, do not discuss or suggest all of the features of claim 1, and there is no proper motivation for combining the references, claim 1 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 3-4, 10-13, 27, and 32-33 depend either directly or indirectly from claim 1 and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 3, 4, 10-13, 24, and 27 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Hollon, Yutaka et al., and Kasahara et al., alone or in combination, do not discuss or suggest:

codes that are output as a result of an operation of each of the plurality of buttons correspond to instructions for each of the plurality of buttons and the instructions differ depending on the operation mode of the electronic apparatus,

as recited in claim 5, and there is no proper motivation for combining the references. Therefore, claim 5 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 6, 15-18, 25, and 28 depend either directly or indirectly from claim 5 and include all the features of claim 5, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 6, 15-18, 25, and 28 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Hollon, Yutaka et al., and Kasahara et al., alone or in combination, do not discuss or suggest:

codes that are output as a result of an operation of each of the plurality of buttons correspond to instructions for each of the plurality of buttons and the instructions differ depending on the operation mode of the electronic apparatus,

as recited in claim 7, there is no proper motivation for combining the references. Therefore, claim 7 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 8, 20-23, 26, 29, and 34 depend either directly or indirectly from claim 7 and include all the features of claim 7, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 8, 20-23, 26, and 29 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

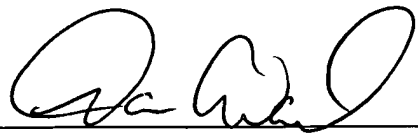
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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